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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/718,390

11/20/2003

Ronald F. Palermo

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37211 7590 01/30/2007  
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EXAMINER

WOLLSCHLAGER, JEFFREY MICHAEL

ART UNIT

PAPER NUMBER

1732

MAIL DATE

DELIVERY MODE

01/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/718,390

Applicant(s)

PALERMO ET AL.

Examiner

Jeff Wollschlager

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1732

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 January 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-13.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant has canceled claims 14-19 in the response filed January 3, 2007. The rejection of previously presented claims 1-13 is traversed. Applicant's amendment to the claims has been entered.

### ***Finality of the Previous Office Action***

Applicant has argued that the finality of the office action of November 2, 2006 is premature. The claims in question are dependent claims 11 and 13. In the first office action, dated 4/18/06, the examiner asserted that limitations found in dependent claims 11 and 13 were well-known in the art. These assertions were accord with MPEP 2144.03:

"Furthermore, it might not be unreasonable for the examiner in a first Office action to take official notice of facts by asserting that certain limitations in a dependent claim are old and well known expedients in the art without the support of documentary evidence provided the facts so noticed are of notorious character and serve only to "fill in the gaps""

In response to the first office action, dated 8/18/06, applicant amended independent claim 1 to overcome the prior art rejections. Regarding dependent claim 11, applicant "respectfully requests the examiner to provide a basis for such a

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conclusion” and pointed out regarding claim 13 that “the rejection urges, without support” the obviousness of the claimed limitation.

Accordingly, the examiner introduced new grounds of rejections in response to changed claim scope resulting from the amendment to claim 1 in a final rejection mailed November 2, 2006. Further, the examiner provided evidence, in the form of applied references, supporting the previous assertions regarding the well-known limitations found in claim 11 and 13, as requested by applicant. The applied reference regarding claim 13 was cited in the first office action (PTO-892) in support of the well-known statement. The applied reference regarding claim 11 was an IDS document. This response and the finality of the office action was also in compliance with MPEP 2144.03:

“If the examiner adds a reference in the next Office action after applicant’s rebuttal, and the newly added reference is added only as directly corresponding evidence to support the prior common knowledge finding, and it does not result in a new issue or constitute a new ground of rejection, the Office action may be made final. If no amendments are made to the claims, the examiner must not rely on any other teachings in the reference if the rejection is made final.”

As such, the examiner maintains that the finality of the previous office action is proper.

***Response to Arguments***

Applicant's arguments filed January 3, 2007 have been fully considered but they do not place the application in condition for allowance.

Applicant's arguments appear to be on the following grounds:

1. As supported by the Abstract of Phillips, "material containing quartz crystals and a coloring agent, but no coarse aggregate" is utilized. As such, Phillips does not apply decorative aggregate as claimed.

2. The claimed invention avoids the multiple steps described by Phillips to deposit the dry shake material.

3. Phillips does not perform the required steps on a partially cured surface as claimed.

4. There is no motivation to combine Shaw with Danielsson.

Applicant's arguments are not persuasive for the following reasons:

1. The examiner agrees that Phillips does not utilize coarse aggregate. Accordingly claim 2, wherein applicant defines the particulate size of the decorative aggregate, is not rejected over Phillips. The material employed by Phillips is considered to be a decorative aggregate meeting the scope of the term as presented in claim 1.

2. The examiner notes that the "comprising" language utilized in the claims is open language. As such, the scope of the claim does not exclude processes employing the same claimed process steps and additional steps.

3. The examiner notes that the compressive strength of the floor at col. 4, lines 16-22 is 4000 psi and this is when the process steps in question are performed. The

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final strength of the floor is 10,000 psi (col. 4, lines 54-62). As such, when the floor has a compressive strength of 4000 psi it is considered to be partially cured.

4. The examiner points to col. 8, lines 11-19 in Danielsson where it is disclosed that grinding the floor prior to it being fully cured improves the efficiency of grinding. As such, one having ordinary skill would have been motivated to modify the teaching of Shaw with Danielsson's teaching regarding when to perform the grinding step in order improve the efficiency of the grinding step.

### ***Conclusion***

All claims remain rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Wollschlager whose telephone number is 571-272-8937. The examiner can normally be reached on Monday - Thursday 7:00 - 4:45, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JW

Jeff Wollschlager  
Examiner  
Art Unit 1732

January 24, 2007

  
CHRISTINA JOHNSON  
SUPERVISORY PATENT EXAMINER  
1/26/07